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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/994,047 12/19/97 GARRISON

D 33500-00001

EXAMINER

TM02/1011

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ROBINSON BOYCE, A

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/994,047

Applicant(s)
Garrison et al.

Examiner
Akiba Robinson-Boyce

Art Unit
2163



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 26, 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

SAM RIVER
PRIMARY EXAMINER
AU 2163

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 10, 11, 16, 22, 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1, 10, 11, 16, 22 and 28, the term "payee zip code" is vague and indefinite. It is confusing to the examiner as to why this term is used in the claim since the "payee zip code" is not used for anything. In the present invention, all records are based on the payee zip code, however, since the payee zip code is not an eleven-digit zip code, it can not be used to access the payee database.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 and 13-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kight et al. (U.S. Patent 5,383,113) in further view of Pollin (U.S. Patent 5,504,677) as discussed in paragraph #2, paper #18.

Response to Arguments

5. Applicant's arguments filed 7/26/01 have been fully considered but they are not persuasive.

As per claims 1-11, the applicant has attempted to challenge the examiner's taking of Official Notice that it is old and well known the payment remittance processing art to process payment information to identify an 11 digit zip code. However, applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice (See MPEP 2144.03). Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The examiner's taking of Official Notice has been maintained. In addition, the Pollin reference discloses that zip codes can be verified and associated with payor/payment input information (Col. 17, lines 1-19). An 11 digit zip code is no more than a zip code which is more specific and identifies a destination delivery point. Furthermore, the applicants arguments in reference to the Pollin and Kight, et al

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references lacking the feature of accessing a database to locate a payee record based on a zip code and failing to disclose processing associated with a payee zip code also applies to the claims of the present invention because as described above in the 112 rejection, the "payee zip code" is not used for anything, therefore, the applicant's argument based on the "payee zip code" do not make sense to the examiner. Although, all records are based on the payee zip code in the present invention, the payee zip code is not an eleven-digit zip code, and according to the claims, in order to access the database, an eleven-digit zip code must be identified, therefore the "payee zip code" is not used at all.

As per independent claims 1, 10, 11, 16, 22, 28 and the claims which depend from them, claims 2-9, 13-15, 17-21, 23-27, the applicant argues that Pollin lacks accessing a database to locate a payee record based on a zip code and deals with fraud prevention and not record location. Further, the applicant argues that Pollin fails to disclose processing associated with payee zip code and that the identity of the payor is known to the Pollin system before the operator has any contact with the payor and therefore no reason to identify, determine or locate a payee record. However, as described above, the Pollin reference discloses that zip codes can be verified and associated with payor/payment input information within a payor's account (Col. 17, lines 1-19).

As per independent claim 28, the applicant argues that Kight, et al fails to teach determining if the stored payees name information/stored payee address information corresponds

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with received payee name information/ payee address information and directing the payment, but instead discloses receiving information identifying the consumer and not the merchant.. However, Kight, et al discloses "Using computer software of the present invention to examine various files to determine the appropriate form of payment based on variables involving banking institutions and merchants" in Col. 2, lines 6-10. These variables identify the merchant

As per the dependencies of claims 1, 11, 16, 22, these claims are rejected as discussed in reference to claims 1, 11, 16, and 22 and also in the rejection of paper #18.

As per claims 2, 17 and 25, the applicant argues that the examiner's rejection is not understood. For clarification, the examiner will explain the reason for her rejection. In Col. 2, lines 45-47 of Kight, et al, this payment system establishes a consumer database for payment processing. This payment information in the consumer database includes the consumers name, address, phone number and other applicable information. The payee address is analogous to both the payee zip code and the payee address information since the address includes a zip code. Since one can input consumer address information to access payment information, this means that consumer address information is affiliated with payment information. Once payment information is processed and accessed, it will include the consumer address information.

As per claims 3, 4, 5, 18, 19, 26, 27, the applicant argues that Pollin does not require the payer to provide any payee information and doesn't show the payee's zip code but rather a payer's zip code. However in combination with Kight, et al, this rejection is valid since Kight, et

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al establishes merchant information at the time of payment. This merchant information includes a merchant address which includes the merchant zip code.

As per claims 6, 7, and 13, the applicant argues that Kight, et al does teach making payments but fails to disclose zip code information. However, Kight, et al does disclose address information which includes zip codes. In addition, in combination with Pollin, the complete zip code information is disclosed as explained in the rejection of paper #18.

As per claims 8, 14, 20, 23, the applicant argues that clarification of the Official Notice rejection is needed. The official notice given in this rejection was directed towards the storage device of claim 14 and not the rules stored within. The stored rules are cited in Kight, et al in Col. 3, lines 4-9. The examiner's reversal of position about Kight, et al teaching validation/alteration rules comes from a closer examination of passage and realizing that the validation rules correspond to comparing the correct routing and bank numbers and the alteration rules corresponding to correcting the data entry.

As per claim 23, the applicant argues that Kight, et al relates to verifying a bank account number and not a merchant account number and also argues that Kight, et al fails to teach that merchant account numbers are validated and altered according to validation and alteration rules. However, Kight, et al does disclose these features in Col. 3, lines 32-35 and Col. 4, lines 47-49 where the account number with the merchant is part of a payment record and the payment record gets validated and verifies that merchants are set up for payments. Also in Col. 4, lines 33-35,

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Kight, et al discloses that the consumer records which contain the account numbers with the merchant are edited for validity.

As per claims 9, 15, 21 and 24, the applicant has attempted to challenge the examiner's taking of Official Notice that it is old and well known to process a merchant account number to identify one of a plurality of remittance centers and to direct payment to that remittance center. However, applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice (See MPEP 2144.03). Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The examiner's taking of Official Notice has been maintained. In addition, the Kight, et al reference discloses that merchant information includes the merchant's address (which is analogous to a remittance center) as well as an account number with a merchant which is put into a merchant master file database (Col. 3, lines 33-36). When retrieving information from a database, it is common to use one entry to access a second entry in a database. For example, in the post office, if one inserts a person's name as an entry in a database, the address for the person would come up for delivery purposes.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

An inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba Robinson-Boyce whose telephone number is (703) 305-1340. The examiner can normally be reached on Monday-Friday from 6:30AM-3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Akiba Robinson-Boyce

Patent Examiner

Group Art Unit 2163

*SAM KIMEL
Patent Examiner
AU 2166*

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October 5, 2001